

REMARKS

Applicants have carefully considered the June 29, 2004 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-15 were pending in this application. Claims 2-3, 5-13 and 15 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). In response to the Office Action dated June 29, 2004, claims 1 and 14 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1, 4 and 14 were provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 1, 4 and 14 of copending Application No. 10/176,606. Applicants respectfully traverse the rejection. Claims 1, 4 and 14 were previously canceled in the copending (Continuation) Application 10/176,606 as evident from the attached copy of the Request Form For Application Under 37 C.F.R. 1.53(b) filed on June 24, 2002. Accordingly, the rejection of present claims 1, 4 and 14 under 35 U.S.C. § 101 is moot.

Claims 1, 4 and 14 were rejected under 35 U.S.C. § 112, first paragraph. The Examiner asserted that the phrase "gas diffusion seats" recited in claim 1 was not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. Applicants respectfully request reconsideration and withdrawal of the rejection of

independent claim 1, as amended, as well as its respective dependent claims. The term “seat” was an inadvertent typographical error and has been replaced with the term “layer”. Thus, claim 1 now recites the phrase “gas diffusion layer”. Support for the amendment is found in the originally filed specification at page 9, lines 19-20. Applicants respectfully submit that the specification fully supports this limitation in such a way as to enable one skilled in the art to make and/or use the invention. Accordingly, the rejection of the claims under the first paragraph of 35 U.S.C. § 112 should be withdrawn.

Dependent claim 14 was rejected under 35 U.S.C. § 112, second paragraph. The Examiner asserted that the phrase “fuel cell proper” was indefinite because it was not known exactly what constituted such a fuel cell. Applicants respectfully request reconsideration and withdrawal of the rejection of dependent claim 14 as amended. The phrase “fuel cell proper” was an inadvertent translational error and the term “proper” has been cancelled from the claim. It should be apparent that a fuel cell per se was originally intended as evident from independent claim 1. Applicants submit that one having ordinary skill in art, with the supporting specification in hand, would be able to reasonably ascertain the scope or protection defined by claim 14. Accordingly, the rejection of claim 14 under the second paragraph of 35 U.S.C. § 112 should be withdrawn.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner’s amendment, the Examiner is invited to call Applicants’ representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including

.10/081,148

extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, reading "Brian K. Seidleck". The signature is written in a cursive, flowing style.

Brian K. Seidleck  
Registration No. 51,321

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
202.756.8000 BKS:apr  
Facsimile: 202.756.8087  
**Date: August 20, 2004**

JC849 U.S. PTO  
06/24/02



10/17/6606 06/24/02

A

# REQUEST FORM FOR APPLICATION UNDER 37 CFR 1.53(b)

JC868 U.S. PTO  
10/17/6606  
06/24/02

DOCKET NUMBER: 62807-069

Prior Application:

Art Unit: 1745

Examiner:

Commissioner for Patents  
Washington, DC 20231

Sir:

This is a Request for filing a Continuation application under 37 CFR 1.53(b) of pending prior application

Serial No. 10/081,148, filed on February 25, 2002, entitled FUEL CELL, POLYELECTROLYTE AND ION-  
EXCHANGE RESIN USED FOR SAME, by the following named inventor(s): Makoto MORISHIMA, Tomoichi  
KAMO, Toshiyuki Kobayashi, Kenji YAMAGA, Tohru KOYAMA.

1. ☒ I hereby state that the enclosed application contains no new matter.
2. Oath or Declaration
  - a. ☐ Newly executed (original or copy)
  - b. ☒ Copy from a prior application (37 CFR 1.63(d))
    - i. ☐ Deletion of inventor(s)  
Signed statement attached deleting inventor(s) named in the prior application, see 37  
CFR 1.63(d)(2) and 1.33(b).
3. ☒ Incorporation By Reference (useable if Box 2b is checked)  
The entire disclosure of the prior application, from which a copy of the oath or declaration is supplied  
under Box 2b, is considered as being part of the disclosure of the accompanying application and is hereby  
incorporated by reference therein.
4. ☒ Preliminary Amendment is enclosed.
5. ☒ An Information Disclosure Statement and PTO1449 Form are submitted herewith.
6. ☒ Cancel claims 1, 4 & 14-15.



20277

PATENT TRADEMARK OFFICE

DOCKET NUMBER: 62807-069

7. The filing fee is calculated on the basis of the claims existing in the prior application as amended at 4 and 6 above:

	NO. OF CLAIMS		EXTRA CLAIMS	RATE	AMOUNT
Total Claims	11	-20	0	\$18.00 =	\$0.00
Independent Claims	1	-3	0	\$84.00 =	\$0.00
Basic Application Fee					\$740.00
If multiple dependent claims are presented, add \$0.00					\$0.00
Total Application Fee					\$740.00
Subtract 1/2 if small entity					\$0.00
<b>TOTAL APPLICATION FEE DUE</b>					<b>\$740.00</b>
<b>AMOUNT TO BE CHARGED TO DEPOSIT ACCOUNT NO. 500417</b>					<b>\$740.00</b>

- 7a. ☐ Enclosed is a Verified Statement to establish small entity status under 37 CFR 1.9 and 37 CFR 1.27.
- 7b. ☐ A verified Statement to establish small entity status under 37 CFR 1.9 and 37 CFR 1.27 was filed in prior application and such status is still proper and desired.
- 8a. ☒ **PLEASE CHARGE DEPOSIT ACCOUNT 500417 in the amount of \$740.00**
- 8b. ☒ The Commissioner is hereby authorized to charge fees under 37 CFR 1.16 and 1.17 which may be required, including any extension of time fees to maintain the pendency of the parent application Serial No. 10/081,148 or credit any overpayment to Deposit Account No. 500417.
9. ☒ Amend the specification by inserting before the first line the sentence:  
 --This application is a Continuation of Application Serial No. 10/081,148 filed February 25, 2002--
10. ☒ Priority of Application Serial No. 2001-388200 filed on December 20, 2001, in JAPAN is claimed under 35 USC 119. The certified priority document was filed in Serial No. 10/081,148 on June 3, 2002.
11. ☒ The prior application is assigned of record to  
**HITACHI, LTD.**  
 Tokyo, JAPAN
12. ☒ The power of attorney in the prior application is to:  
 McDermott, Will & Emery
13. ☐ Also enclosed:

DOCKET NUMBER: 62807-069

14. ☐ A petition, fee and response has been filed to extend the term in the pending prior application until .

Address all future communications to: (May only be completed by applicant, or attorney or agent of record)

McDermott, Will & Emery  
600 13th Street, N.W.  
Washington, DC 20005-3096

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Keith E. George  
Registration No. 34,111

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202)756-8000 KEG:prp  
Facsimile: (202)756-8087  
Date: June 24, 2002